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Remarks1) Status Summary

Claims 3 – 46 are pending in the case.

Claims 33 – 46 have been allowed.

Claims 3 – 10, 12- 15, 18, 20, 23 – 26 and 28 – 32 are rejected.

Claims 11, 16, 17, 19, 21, 22, and 27 are objected to.

There are no longer any rejections under 35 USC 112.

The Office action of December 24, 2003 is non-final.

2) Rejections Under 35 U.S.C. 102 - Anticipation(i) Test for Anticipation

In the interest of brevity, the applicant incorporates, by reference, the statement of the law on Anticipation under 35 USC 102 provided in the response of November 12, 2003.

iii) US Patent 5,782,187 of Black, Jr.

The Examiner has again rejected claims 3-7, 9-10, 13-15, 20, 23, 24-26, 29-32 as being anticipated by Black, Jr., et al.

The test for anticipation requires that the cited reference show all of the elements of the claim in exactly the same situation and united in the same way to perform the same function. Consider, first, claim 3:

I) The claim is premised on the existence of bridge plates that span the gap between the coupler ends of the two rail road cars. As discussed at length previously, and below, Black does not meet this requirement.

- (a) Black shows one railroad car, not two.
- (b) Black does not show the coupler ends of the railroad car.
- (c) Black does not show coupler end bridge plates.
- (d) Black does not show a gap between two coupled railroad cars.
- (e) Black does not show bridge plates spanning the gap between the coupler ends of two coupled railroad cars

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II) The claim is premised on the idea that the bridge plate can be disengaged from the coupler end of the second rail road car. There is nothing in Black that shows this capability.

To suggest that with "proper tooling" Black's internal plates can be disengaged (a) requires conjecture, contrary to *Datascope*, previously cited; (b) is to supply information that is clearly not found in the reference as required by *Structural Rubber Products* and *Kohle*; and (c) is a non-sequitur in any case, since the issue is not whether internal bridge plates can be disengaged, but whether coupler end bridge plates are to be disengaged – that is, the applicant respectfully submits that not only does Black not show the bridge plates to be disengageable, but, in addition, the internal bridge plates shown by Black are the wrong bridge plates anyway.

III) The claim is premised on the idea that the bridge plate can be moved from a longitudinal orientation to a cross-wise orientation. There is nothing in Black that suggests that Black's plates are, ever have been, or ever will be, movable between a longitudinal position and a cross-wise position.

IV) Summary Re: Anticipation

The test for anticipation is not satisfied by Black. The applicant submits that none of the rejections of claim 3 or any claim dependent from claim 3, under 35 USC 102 made on the basis of US Patent 5,782,187 of Black, Jr., et al., are supportable. The applicant respectfully requests that the rejections be withdrawn.

V) Claim 13 and Claims 14 – 15 Dependent Therefrom

In the context of Claim 13, to the extent applicable, the applicant repeats the commentary made above in the context of Claim 3 and all claims dependent therefrom. Specifically, there is no enabling disclosure in Black of bridge plates at the coupler ends of two railroad cars where the bridge plates are disengageable from the adjacent railroad car.

The applicant respectfully requests that the rejections of claims 13 to 15 under 35 USC 102 in light of Black be withdrawn.

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VI) Claims 20 and 23

In the context of Claims 20 and 23, to the extent applicable, the applicant repeats the commentary made above in the context of Claim 3 and all claims dependent therefrom. Specifically, there is no enabling disclosure in Black of bridge plates at the coupler ends of two railroad cars where the bridge plates are disengageable from the adjacent railroad car.

The applicant respectfully requests that the rejections of claims 20 and 23 under 35 USC 102 in light of Black be withdrawn.

VII) Claim 24 and claim 25, 26 and 29 – 32 dependent therefrom

In the context of Claims 24, 25, 26 and 29 - 32, to the extent applicable, the applicant repeats the commentary made above in the context of Claim 3 and all claims dependent therefrom. Specifically, there is no enabling disclosure in Black of bridge plates at the coupler ends of two railroad cars where the bridge plates are disengageable from the adjacent railroad car.

The applicant respectfully requests that the rejections of claims 24 – 26 and 29 - 32 under 35 USC 102 in light of Black be withdrawn.

3) Claim Rejections Under 35 U.S.C. 103 – Obviousness - Law

In the interest of brevity, the applicant hereby repeats, and incorporates by reference, the statements of the law of the Response to Office Action of March 18, 2003.

4) The Rejections(i) Commentary re: Combination of US Patent 5,782,187 of Black, Jr., et al., and US Patent 3,195,478 of Thompson

The Examiner has cited the combination of Black, Jr., et al., and Thompson, against claims 8, 12, 18 and 28. According to the Office Action, Black teaches all of the limitations of claims 12, 18 and 28 except for (a) a railroad car bridge plate having traction bars on the upper surface and (b) a handgrab mounted thereto.

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(ii) Commentary on Thompson '478

The Examiner again contends that it would have been obvious to one of ordinary skill in the art to modify the bridge plate of Black, Jr., et al., to include the use of a handgrab as taught by Thompson.

As a preliminary matter, for the reasons discussed above, the applicant traverses the contention that Black teaches all of the limitations of claims 8, 12, 18 and 28 except traction bars and a handgrab. However, even if it were true, (which it is not), the rejection would fail for lack of motivation, suggestion or incentive to combine.

The bridge plate construction of Thompson is clearly neither designed, nor intended, to remain in a position spanning two railroad cars during transit. In column 2, lines 19-21, among the objects of his invention, Thompson states:

"...which bridge plate and which bridge plate supports are adapted to be swung from a loading position to a transit position."

Further, as illustrated in Figure 3 and described at column 3 lines 45- 50,

"which bridge plate is pivotally mounted...for swinging movement between a generally horizontal loading position and a generally vertical transit position."

(iii) No Suggestion Motivation or Incentive Demonstrated

None of the office actions has identified a source in the cited references from which a person skilled in the art would infer there to be a suggestion, motivation, or incentive to combine the cited references to arrive at the invention of any of claims 8, 12, 18 and 28. As such no *prima facie* ground for rejection has been established under 35 USC 103. On that ground alone, if no other, the applicant respectfully submits that it is entitled to request withdrawal of the current rejection of claims 8, 12, 18 and 28.

(iv) No Reason to Combine

Thompson's handgrabs are intended for use in swinging the plate into a vertical position for transit. Inasmuch as the bridge plates of Black, Jr. are apparently intended to stay in place spanning the articulated connector between two rail car units, what would Thompson's hand grabs be used for on Black's internal bridge plates? The Examiner has not pointed to any explanation in the objective art of record of why a Black's internal bridge plates would require,

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or benefit from having, a handgrab. The applicant submits that a person of ordinary skill in the art would not be motivated to modify Black, Jr., to include the use of a handgrab, since this modification would not appear to provide any advantage to Black, Jr.

In the event that the Examiner seeks to maintain the rejection, the Applicant specifically requests that, in accordance with *In Re Kotzab*, the Examiner demonstrate where in the objective art of record in this case, there is an explanation of why a person skilled in the art would be motivated to make the proposed combination.

(v) Thompson Teaches Against the Invention

To the extent that any current rejection under 35 USC 103 employs Thompson, and given that Thompson expressly teaches away from leaving the bridge plates in place during train operation, the applicant submits that no rejection under 35 USC 103 is supported by Thompson.

(vi) Black, Jr. and Thompson: References Teach in Opposite Directions-
No Motivation to Combine

Even on the Examiner's own characterisation of Black Jr. (which the applicant traverses), Black Jr. shows bridge plates, albeit internal bridge plates rather than coupler end bridge plates, that stay in place during train operation. By contrast, Thompson (a) shows (b) includes in the objects of his invention; and (c) claims, bridge plates that are to be raised to a vertical position for transit.

Since, if anything, the cited references teach in opposite directions, the applicant submits that no motivation to combine the two references can be found. As such, applicant submits that no basis for a *prima facie* rejection under 35 USC 103 has been established. Therefore the applicant respectfully requests withdrawal of the rejections under 35 USC 103.

(vii) Bell

Curiously, although the Office Action of December 24, 2003 no longer states that any of claims 8, 12, 18 or 28 are unpatentable in view of US Patent 4,721,426 of Bell, nonetheless the commentary in the Office Action of December 24 still discusses Bell. The applicant assumes that this is an inadvertent word processing error. In the event that it is not, the applicant repeats,

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and incorporates by reference, the arguments presented in the response to office action of March 14, 2003 with respect to Bell.

8) The Examiner's Reply Commentary

The First Argument: Coupler Ends

The Office Action summarises the applicant's first argument as

"1. The reference cited in the '102 rejection, Black Jr., et al., fails to disclose a bridge plate at the coupler end of the railroad cars."

In response, the Office Action of December 24, 2003 says:

"In response to applicant's argument number 1, it must be recognized that Black Jr., et al., disclose a railroad car bridge plate that spans the gap between two railroad cars as recited in the claims. The bridge plate has been identified as item number 32 in the rejection above. Also the connection between the bridge plate (32) and the railroad car (22) is disclosed in col. 2, lines 50 – 64 of the reference and as shown in Figs 5 – 6, and 8."

Applicant's Rebuttal

The applicant respectfully submits that the citation given, and the Figures noted, in the Examiner's reply (a) do not support the rejection; and (b) do support the applicant.

Col. 2, lines 50 – 64 read as follows:

"The pivot plate assembly also may comprise *bridge plates for spanning the gap between the respective first and second units of the railway car*. The bridge plates provide supporting surfaces for rolling of vehicle over the articulation from one of the platforms to the other to facilitate rolling loading and unloading of vehicles from one unit to another.

The platforms may partially overlap the bridge plates to provide a continuous, uninterrupted movable support surface to be provided adjacent the articulation. Each of the platforms preferably comprises one or more molded polymeric structures having a ribbed bottom surface to provide light weight while maintaining high strength and rigidity." (Emphasis added).

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The applicant again draws the Examiner's attention to Black's text, and to Black's Figures. The key concept that does not seem to have been understood by the Examiner throughout this prosecution is that Black's Figures 1 to 6 illustrate a portion of a single articulated rail road car.

By definition, an articulated railroad car (singular) has two or more rail road car body units (plural). The individual body units are not separate railroad cars.

Black shows an internal portion of a rail road car (singular).

Black's rail road car (singular) includes item 22a and item 22b, namely a pair of first and second rail road car units (plural) of Black's rail road car (i.e., "*of the railway car*", the definite article "the" being employed by Black).

Hence, in clear contradiction of the Examiner's position, the quotation cited in the Office Action of December 24, 2003 clearly states that Black has bridge plates that span the gap between "*the respective first and second units (plural) of the railway car (singular)*".

The applicant respectfully submits that neither the cited quotations, nor the cited illustrations support the rejection made in the office action. On the contrary, they strongly support the oft reiterated position of the applicant.

- (a) Black does not, in any Figure, illustrate a coupler end of any railroad car.
Black does refer to the internal articulated connection of a single articulated railroad car.
- (b) Black does not, in any Figure, illustrate two rail road cars coupled together.
Black does show portions of two rail car units of a single articulated railroad car.
- (c) Black does not, in any Figure, show bridge plates spanning the gap between the coupler ends of two rail road cars.
Black does show internal bridge plates spanning the internal gap at the articulated connector.

The applicant respectfully submits that any one of these grounds would be sufficient to overcome the present rejection under 35 USC 102.

The first point is that the claim is based on a connection at (a) the coupled ends of (b) two railroad cars. The applicant discussed this in the second and third full paragraphs at page 7 of the applicant's Response to Office Action of March 18, 2003, and again in the response of November 12, 2003 as follows:

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Figures 1-8 of Black, Jr., cited by the Examiner, show an internal bridge plate. They do not reveal anything about the coupler end bridge plates. Items 22a and 22b are not adjacent rail road cars. On the contrary, car units 22a and 22b are units of a single articulated rail road car as plainly indicated by Black, Jr., at, for example, col. 4, lines 1-7. The Examiner's attention is also drawn to Figures 1 and 2 of Black, Jr., which show a single railway truck supporting the two interconnected units 22a and 22b.

The Office Action does not responded to this argument. Specifically:

- 1) It does not acknowledged that Black items 22a and 22b are units of a single articulated railroad car, not two railroad cars.
- 2) It does not acknowledged that Black does not show coupler end bridge plates.
- 3) The Examiner has not acknowledged that Black item 32 is not a coupler end bridge plate.

The Office Action does not address any of these points, although they were clearly, and repeatedly, raised in the applicant's previous responses.

(II) The Second Argument: Bridge Plates Are Disengageable "if proper tooling is provided".

"Disengageable"

The Office Action again suggests that the internal bridge plates are disengageable.

There is nothing in Black to support this suggestion. This issue has been covered at great length in the previous responses to office action. The subsequent Office Actions have not responded to the specific points raised by the applicant in this regard. The applicant respectfully submits that the word "disengageable" can not reasonably be interpreted as meaning that the car can be dismantled. The applicant respectfully submits that the installation shown by Black is clearly intended to be a permanent installation, spanning the permanent articulated connector.

The applicant again disagrees with the bold, and incorrect, assertion that "it must be recognized that Black Jr et al meet all of the limitations of claims 3 - 7". Black does not meet the limitations of the claims 3 - 7, as discussed at length both in this response and previously.

First, if a rejection is to be made under 35 USC 102, then a basis for this "proper tooling" comment must somehow be present in the reference. Clearly, there is not.

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Second, a rejection under 35 USC 102 cannot be based on conjecture. (See *Datascope, supra*). The "proper tooling" statement is one of pure conjecture.

Third, a rejection cannot be based on unsupported conclusory statements by an Examiner. This statement concerning "proper tooling" is unsupported by anything in the evidence of record in this case. Thus far, nothing has been identified in the objective art of record in this case, whether in Black or in any other reference, to support this "proper tooling" statement.

Fourth, the Examiner's statement relies on the assumption that the ability to dismantle the bridge plate is equivalent to being "disengageable". The applicant respectfully submits that grounds for this assumption have not been demonstrated in the objective evidence of record in the case. By way of example, with "proper tooling" (i.e., in the nature of a cutting torch) the center sill, or the main bolster, can be removed from the car. Yet that would hardly make the center sill or the main bolster "disengageable" in any reasonable meaning of the word. The applicant respectfully submits that a person skilled in the art, having no knowledge of the present application, but being aware of Black, could not reasonably be expected to understand that the word "disengageable" encompasses obtaining "proper tooling" to dismantle Black's apparatus, or to understand that because Black's apparatus can, ultimately, be taken apart, that the feature is therefore "disengageable". The applicant respectfully submits that a person skilled in the art, considering Black's illustrations would understand them to be of a substantially permanent installation that would not be intended to be "disengaged" in the normal course of operation.

More importantly, there is no indication in Black that the parts are intended to be taken apart after they have been assembled, nor is there any indication that, as an ordinary incident of daily operation, they are intended to be taken apart, nor that it is desirable for them to be taken apart, on a casual basis to permit the bridge plates to be disengaged.

If the Examiner is unwilling to concede this point, the applicant respectfully requests that the Examiner demonstrate, by column and line number or by Figure and item number, where in the Black reference or any other, there is any indication that the features identified by the Examiner are (a) intended to be taken apart after assembly; or (b) are intended to be dismantled as an ordinary incident of operation to permit plates 32 to be disengaged.

Fifth, the Examiner has not demonstrated a suggestion in the art that it would be desirable to dismantle Black's apparatus. That is, the Examiner contends that Black's apparatus can be taken

apart, thus yielding (in the Examiner's view) the presently claimed invention. Yet the apparatus that the Examiner proposes to dismantle is part of Black's claimed invention. The applicant respectfully submits that there is no reason why a person skilled in the art would perceive it to be desirable to dismantle Black's invention, whether with "proper tooling" or without. The applicant respectfully submits that a rejection that relies on the ability to dismantle part of the claimed invention of the cited prior art reference is not sound. (See: *In re Gordon*).

In summary, the present rejection relies not merely on (a) an assumption of the ability to dismantle Black's apparatus, but, additionally, on (b) the assumption that Black's apparatus is *intended* to be dismantled in the ordinary course; on (c) the assumptions that a person skilled in the art would *infer* the ability to dismantle Black's apparatus, on (d) the assumption that a person skilled in the art would *infer* that Black's apparatus is intended to be dismantled as an ordinary incident of operation; on (e) the assumption that a person skilled in the art would infer the *desirability* of being able to dismantle Black's apparatus; and finally on (f) the assumption that the person skilled in the art would *construe* all of these things to mean "disengageable".

The applicant respectfully submits that a rejection made on this basis clearly does not satisfy the test for anticipation under 35 USC 102.

The Third Argument: Movable to a Cross-Wise Position

The Office Action takes the position that the internal bridge plates 32 of Black are "fully capable of moving from a longitudinal orientation to a crosswise orientation ..."

The applicant traverses this statement.

First, as noted above, the bridge plates are internal bridge plates at an articulated connector. They are not coupler end bridge plates.

Second, while internal bridge plates 32 may be able to accommodate a measure of yaw, they do not appear to be movable to a cross-wise position. In that regard the Examiner may wish to consider Black's item 112 shown in phantom in Figures 5, 6 and 7. Given the location of item 112, the applicant respectfully requests that the Examiner explain how internal bridge plate 32 could be moved to a cross-wise position. The applicant respectfully submits that the Examiner's statement in this regard, and the rejection based upon it, are not sound.

The Fourth Argument: Motivation to Combine

In dismissing the Applicant's arguments pertaining to the rejection under 35 USC 103 based on the combination of Thompson and Black, the Office Action of December 24, 2003 states only:

"In addition, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Black Jr., et al to include the use of a hand grab to the bridge plate assembly in his advantageous bridge plate as taught by Thompson '478 in order to facilitate rotation of the bridge plate when the railroad cars are disconnected for service."

Thompson

Thompson has a handle to permit Thompson's bridge plate to be raised and lowered between "a loading position and a transit position" (Thompson col. 2, lines 14 – 21: "It is an object of the present invention to provide ... a bridge plate ... at the end of the flat car ... which bridge plates are adapted to be swung from a loading position to a transit position." (*I.e.*, the loading position, across the gap, is not the transit position – the antithesis of staying in place during transit).

First, the office action presumes that someone would want to "facilitate rotation of [Black's] bridge plate". There is no explanation of why anyone would ever want, or need, to rotate Black's bridge plate in the first place: Black shows a permanent installation. The office action fails to address this point.

Second, there is a presumption that the "railroad cars" are "disconnected for service". As noted several times, (a) Black does not show railroad cars (plural), but rather one railroad car (singular); and (b) there is nothing, apparently, in Black or any other reference, about Black's invention being "disconnected for service".

Third, Black does not have, and does not need, a handle to swing the plate, because Black's internal bridge plates are apparently not intended to be, and may not be able to be, swung to a cross-wise position.

Fourth, Thompson clearly teaches away from the present invention by teaching that it is "an object" of his invention to provide a bridge plate that is movable to a vertical transit position, not one that can stay in place spanning the gap between the cars during transit. (See also Thompson col. 3 lines 45 et seq., noted above).

The Office Action does not address these points.

6) Hindsight Analysis

The Examiner formerly commented that "... it should be noted that the combination rejection was simply based on a teaching of a handle that is disclosed by the prior art of record, Thompson, which disclose a handle attached to the side of a bridge plate for the purpose of moving the plate out of position."

This admission no longer appears in the Office Action of December 24, 2003. In that regard, the applicant repeats, by reference, the commentary made in the response to office action of November 12, 2003. However, while this admission has been deleted, no other explanation has been provided in its place. It appears that the current rejections under 35 USC 103 continue to be made on the same hindsight basis as previously, but without the previously made admission. The applicant respectfully submits that the issues raised with respect to hindsight analysis have not been addressed in the Office Action of December 24, 2003. The applicant again requests an explanation of the remarks of the Office Action of May 13, 2003.

7) Statements of The Law and Application of the Law

Previous office actions in this matter contained assertions concerning the law that appear to have been without foundation in the statute, the regulations, or the caselaw. Indeed, the applicant respectfully submitted that some of the statements were either incomprehensible, or directly contrary to the law. Inasmuch as those points were, and are, fundamental to the examining process, the applicant respectfully and explicitly requested specific clarification of those points. No such response has been provided.

The applicant requested a full explanation of those statements in the response to Office Action of August 26, 2002. The applicant again requested an explanation of those statements in the Response to Office Action of March 18, 2003. For a third time, the applicant requested an explanation in the Response to Office Action of November 12, 2003. Now, for a fourth time, the applicant requests a full explanation of the statements of the law formerly made by the Examiner.

To date, there is no evidence to show that the Office Actions apply the law, or attempt to apply the law, any differently than as formerly, and erroneously done. The applicant therefore respectfully requests either (a) an explanation of the former commentary; or (b) (i) an acknowledgement that the former statements of the law were incorrect; and (ii) a demonstrably

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correct application of the law, MPEP 2142, and *In re Lee* to the currently presented claims and the art of record in this matter.

8) Interview Requested

As the record should show, the applicant has rigorously attempted to distinguish the prior art in writing for the Examiner. To expedite prosecution, if the Examiner believes that an interview, particularly a telephone conference involving the undersigned attorney and the Canadian correspondent attorney, would help to resolve the matter, the applicant hereby requests that the Examiner contact the undersigned attorney to arrange such an interview.

9) Conclusion

In view of the foregoing arguments, the applicant submits that claims 3 – 46 presently pending in this case are in a condition to permit allowance. Therefore the applicant requests early and favourable disposition of this application.

Respectfully submitted,



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